

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

In the present Reply, claims 5 and 6 have been amended into independent form. In the Office Action, claims 5-6 were objected, but would be allowed if properly rewritten (see paragraph 4, page 2 of the Office Action). Thus, claims 1-6 are pending in this application. No new matter has been added, since each claim as amended incorporates the subject matter of original claim 1.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 102(b)

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Goodman *et al.* '543 (U.S. Patent No. 4,998,543) (see paragraph 2 of the Office Action). Also, claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by EP '688 (EP 0791688) (see paragraph 3 of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of these

rejections are respectfully requested based on the following remarks.

The Present Invention and Its Features

The present invention is directed to a wrapper paper for a smoking article, which decreases an amount of visible sidestream smoke of tobacco. In the present invention, the claimed wrapper paper comprises at least 30 g/m² of calcium carbonate and at least 3% by mass of a burn adjusting agent. With the present invention, the user of the present invention experiences unexpectedly less sidestream smoke. Even such unexpected advantages of the present invention have been experimentally confirmed (as explained in Applicants' specification at pages 25-34 using Examples 1-3; see also the Tables, such as Table 1 on page 28).

In contrast, each of the cited references of Goodman '543 and EP '688 fails to disclose all features and advantages of the present invention.

Lack of Disclosure of Claimed Features of the Present Invention

Applicants respectfully submit that each of Goodman '543 and EP '688 fails to disclose the amount of calcium carbonate as instantly claimed. First, Applicants discuss the differences between using the "fishtail method" of measuring smoke versus

visual measurements of sidestream smoke. Then, distinctions over each of Goodman '543 and EP '688 are explained.

Whether or not a cigarette actually generates a small amount of smoke can be determined by the "fishtail method" (see Applicants' specification at page 1, lines 22+). The fishtail method is further described in Japanese Patent Disclosure (Kokai) No. 10-81 (as stated in the present specification at page 1, lines 25-27), wherein this method involves measurements of the amount of total particulate matter (see the present specification at page 3, line 27 to page 4, line 10). As explained in Applicants' specification, however, the amount of measured particulate matter (i.e., via the fishtail method) can differ from the visual measurements of sidestream smoke. An object of the present invention is to reduce such visual sidestream smoke (see the present specification at page 4, last paragraph; see also page 14, lines 3-12 and Figures 1-3).

The amount of visible sidestream smoke is the amount of sidestream smoke that is measured by visual observation. In fact, each of Examples 1-3 of Applicants' specification (at pages 25-34) clearly demonstrates the amount of sidestream smoke that is visually observed is significantly reduced when the instantly claimed wrapper paper is used. This is because the present invention uses 30 gm² or more of calcium carbonate and 3% by mass

or more of a burn adjusting agent. Also in Examples 1-3, the amount of sidestream smoke as measured using the fishtail method does not significantly vary or change (i.e., see Table 1 on page 28). Thus, one of skill in the art can see how the measurements using the fishtail method differ from visual observation measurements based on the present specification.

(A) Distinctions over Goodman '543

The Examiner refers Applicants to column 1, lines 25-59 of Goodman '543 for asserted disclosure of the instantly claimed features. Still, Goodman '543 fails to disclose all instantly claimed features.

At column 1, Goodman '543 describes a cigarette having double wrapping of paper around tobacco. The Goodman '543 outer paper has a basis weight of about 30-70 g/m² and contains about 3-40% by weight of calcium carbonate; the inner paper of Goodman '543 has a basis weight of about 15-25 g/m² and contains 2-15% by weight of calcium carbonate (see column 1, lines 25-59). Thus, the outer paper of Goodman '543 contains $70 \text{ g/m}^2 \times 40\% = 28 \text{ g/m}^2$ of calcium carbonate as a possible maximum value. The inner paper of Goodman '543 contains $25 \text{ g/m}^2 \times 15\% = 3.75 \text{ g/m}^2$ of calcium carbonate as a possible maximum value. Both values for either paper of Goodman '543 fall outside of what is instantly claimed.

Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited Goodman '543 reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Goodman '543 is overcome. Reconsideration and withdrawal are respectfully requested.

(B) Distinctions over EP '688

The Examiner refers Applicants to pages 3-4 of the cited EP '688 reference. However, Applicants respectfully submit that EP '688 merely discloses that calcium carbonate can maintain the side stream smoke reducing effect that is intrinsic to pulp (see page 8, lines 56-57 after Table 1). The effect of calcium carbonate that is intrinsic in pulp decreases when the amount of calcium carbonate increases, as is clearly indicated in Table 1 shown at page 8, lines 23-54 of EP '688.

Further in EP '688, the sidestream smoke reducing effect is seen only when calcium carbonate is combined with calcined clay (see page 12, lines 49-51) and when calcium carbonate is used with calcined clay and kaolin (see page 22, lines 53-54 of EP '688). In

this regard, using calcium carbonate even gave inferior results (see the paragraph bridging pages 8-9 of EP '688).

In addition, the effect of a burn adjusting agent is only mentioned when the agent is combined with the mentioned calcined clay and calcium carbonate (as described at page 13, lines 39-43 of EP '688) and when the agent is used with the kaolin, calcined clay and calcium carbonate, as discussed in the preceding paragraph. The cited EP '688 reference does not disclose or recognize the effect brought about by a combination of a burn adjusting agent and a certain amount of calcium carbonate as instantly claimed.

Furthermore, the cited EP '688 reference fails to disclose or suggest the "visible sidestream smoke" as defined in the present invention. Although the term "visible side stream smoke" is disclosed in EP '688 (i.e., see page 7, lines 12-13), this disclosed visible side stream smoke is measured via the fishtail method (page 7, line 13 in part states "... in accordance with a fishtail method") and is quite different from the present invention (the differences in the methods are discussed above).

Therefore, EP '688 fails to disclose all features as instantly claimed. Under *Verdergaal Bros.*, Applicants respectfully submit that this rejection has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

Application No. 10/706,038

Art Unit 1731

Reply to Office Action of September 20, 2004

Substance of the Interview

Applicants thank the Examiner for his time, helpfulness and courtesies extended during the Interview of September 28, 2004. The Interview Summary form amply summarizes the discussions at the Interview, which mainly concerned the acceptability of the originally filed drawings. The Examiner finds the Applicants' drawings as acceptable.

Conclusion

Applicants respectfully request allowance of claims 5-6, since these claims have been properly written into independent form. Further, Applicants respectfully request allowance of pending claims 1-4 for the reasons stated above.

A full and complete response has been made to the Office Action. The Examiner is respectfully requested to pass the application to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/706,038

Art Unit 1731

Reply to Office Action of September 20, 2004

Pursuant to 37 C.F.R. § 1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a response in connection with the present application. The required fee of \$120.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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